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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/289,957	04/13/1999	JOHN S. HENDRICKS	026880.00024	9303
4372	7590	03/25/2008		
ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER WINTER, JOHN M	
			ART UNIT	PAPER NUMBER
			3621	
			NOTIFICATION DATE	DELIVERY MODE
			03/25/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com

IPMatters@arentfox.com

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### Office Action Summary

**Application No.**

09/289,957

**Applicant(s)**

HENDRICKS ET AL.

**Examiner**

JOHN M. WINTER

**Art Unit**

3621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2, 4-41, 43-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2, 4-41, 43-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/02)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

The Applicants amendment filed on September 28, 2007 is acknowledged, Claims 2, 4-41, 43-58 remain pending.

### ***Priority***

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows: The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the continuing application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971). In this case, the subject matter of the instant application as claimed in independent claim 17 is not sufficiently disclosed in any of the parent applications (08,336,247 now U.S. Patent No. 5,986,690; 08,160,194 now U.S. Patent No. 5,990,927 or 08,946,469 now U.S. Patent No. 6,408,437) in order to comply with the requirements of the first paragraph of 35 U.S.C. 112. Thus, the priority dates of 7 November 1994 (5,986,690), 29 December 1993 (5,990,927) and 5 August 1997 (6,408,437) respectively have not been granted.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4-41 and 43-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartrick et al. (US Patent 5,532,920) in view of Wolfe (US Patent 4,796,220) .

As per claim 2,

Hartrick et al. ('920) discloses an apparatus that provides electronic books to a subscriber, comprising;

a processor that communicates with an electronic book ordering site, the processor supplying an electronic book selection and a processor identification; (Column 12, lines 20-33 )

a transmitter, coupled to the processor, that sends the electronic book selection and the processor identification to the ordering site (Figure 8A);

a receiver module that receives a data signal and a local authorization code, wherein the data signal comprises an encrypted electronic book selection and wherein the local authorization code allows the data signal to be decrypted for viewing;(Figure 9A)

a memory coupled to the receiver module, the memory storing the received authorization code until needed for decrypting the data signal. (Column 6, lines 61-67)

a viewer capable of receiving data, wherein the viewer, comprises: a decryptor that decrypts the data signal, a display that displays pages of the electronic book, a book memory that stores the electronic book, and a control module that controls viewing of the electronic book (Column 7, lines 20-47)

Hartrick et al. ('920) does not explicitly disclose "wherein the local authorization code includes an expiration, wherein upon occurrence of the expiration, the selected electronic book cannot be decrypted using the local authorization code" Wolfe ('220) ('515) discloses "wherein the local authorization code includes an expiration, wherein upon occurrence of the expiration, the selected electronic book cannot be decrypted using the local authorization code" . (Column 7, lines 24-56) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Hartrick et al. method with the Wolfe method in order to securely distribute software

Claims 4-41 and 43-58 are not patentably distinct from claim 2 and are rejected for at least the same reasons.

### ***Response to Arguments***

The Applicant's arguments filed on September 28, 2007 have been fully considered. The pending claims are rejected in view of Hartrick et al. (US Patent 5,532,920) in view of Wolfe (US Patent 4,796,220). The Examiner states that many of the claims features are not supported fully by the applications the present application claims priority from, therefore the claimed priority has been denied. The Examiner would like to request an interview with the Applicants representative.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John Winter  
Patent Examiner -- 3621

/ANDREW J. FISCHER/  
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